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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,334	11/12/2003	David G. Kuehr-McLaren	RSW920010113US1	6032

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EXAMINER	
AUGUSTIN, EVENS J	

ART UNIT	PAPER NUMBER
3621	

MAIL DATE	DELIVERY MODE
02/04/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/706,334	KUEHR-MCLAREN ET AL.	
	Examiner	Art Unit	
	EVENS J. AUGUSTIN	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 October 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. This is in response to an amendment filed on10/08/21008. Claims 1-18 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barzilai et al. (U.S. 20020029201) ("Barzilai"), in view of Bowman-Amuah (U.S. 6697824) ("Bowman").

4. As per claims 1-18, Barzilai discloses an invention comprising of storage medium/software combination means (¶ 42-43, 50-52 and figure 1) to perform the following:

   A. **("obtaining digitally-signed privacy-use information for each participant; "); ("privacy information comprises a P3P policy ")** –The marketplace prompts the user for privacy policy information, preferably based on a standard form or language for recording privacy preferences and choices, such as an extension of the above-mentioned P3P standard (¶ 12, 24, 46). Marketplace also obtains seller's privacy policy (¶ 13), which has to match the buyer's;

   B. ("sharing the digitally-signed privacy-use information with any participants interested in doing business with each other in the E-marketplace") –

Marketplace shares buyer's privacy policy with sellers that have compatible policies (¶ 14, 22, 24);

C. The information is made available to all eligible to receive the information (i.e., buyers and sellers) (¶22, 24);

D. **("requesting each participant to submit said digitally-signed privacy-use information to the E-marketplace as part of a registration procedure for the E-marketplace ")** –With regard to the registration process, Merriam-Webster's dictionary describes register as: "1 a: to make or secure official entry of in a register b: to enroll formally especially as a voter or student c: to record automatically : indicate d: to make a record of : note e: perceive;". The prior art teaches that a buyer, seeking to purchase an item of goods or services of a particular type, logs into the market maker's Web site, at a log-in step 30 (¶ 54). According to Merriam-Webster's dictionary, to log is described as: "2: to make a note or record of : enter details of or about in a log ". In this case, log-in step is equivalent to the registration step because both take entries of information about the users;

E. **("and storing all of said submitted digitally-signed privacy-use information") –** Storing information (¶ 14, 79);

5. Barzilai did not explicitly describe an invention in which the privacy information received from the users is digitally signed.

6. However, Bowman describes an e-commerce environment in which information received from sender/receiver is digitally signed (Col. 68, Lines 20-26). Therefore, it would have

been obvious for one skilled in the art, at the time of applicant's invention to implement digital signature in an invention that deals with privacy in an electronic marketplace.

7. The motivation for doing so would be to ensure that the identities of the sender and receiver of information in a digital marketplace are known and the information sent arrives unaltered (Bowman, Col, 70, Lines 28-34 and 58-67).

8.

Response to Arguments

1. The United States Patent and Trademark Office has fully considered the applicant's arguments filed on 10/08/2008, but has not found those arguments to be persuasive.

Argument 1: Examiner has not established a prima facie case of obviousness

Response 1: According to MPEP 2142, the key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in KSR International Co. v. Teleflex Inc., 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." In re Kahn, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR , 550 U.S. at ___ , 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

As such, Barzilai did not explicitly describe an invention in which the privacy information received from the users is digitally signed. 10. However, Bowman describes an e-commerce environment in which information received from sender/receiver is digitally signed

(Col. 68, Lines 20-26). Therefore, it would have been obvious for one skilled in the art, at the time of applicant's invention to implement digital signature in an invention that deals with privacy in an electronic marketplace. 11. The motivation for doing so would be to ensure that the identities of the sender and receiver of information in a digital marketplace are known and the information sent arrives unaltered (Bowman, Col, 70, Lines 28-34 and 58-67).

Conclusion

2. **THIS ACTION IS MADE FINAL.** Any new ground(s) of rejection is due to the applicant's amendment. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
3. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.
4. In determining patentability of an invention over the prior art, the USPTO has considered all claimed limitations, and interpreted as broadly as their terms reasonably allow. Additionally,

all words in the claims have been considered in judging the patentability of the claims against the prior art.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EVENS J. AUGUSTIN whose telephone number is 571-272-6860. The examiner can normally be reached on 10am - 6pm M-F.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571)272-6779.

/Evens J. Augustin/
Evens J. Augustin
February 4, 2009
Art Unit 3621